

## **REMARKS**

Applicant has noticed upon review of the U.S. Patent Office Private PAIR website, that the amended title submitted in an Amendment mailed on November 9, 2006 has not yet been changed within the U.S. Patent Office records. Applicant respectfully requests that the title of this application be changed as submitted in the Amendment mailed on November 9, 2006.

### Interview Summary

A telephone interview was conducted between Applicant's Attorney, Ken Smith, and Examiner John Bastianelli on March 7, 2007. Applicant asserted that the statement "Regarding MPEP 2125, this is for measuring distances in the drawings not ratios which are relative to one another" is incorrect. Examiner Bastianelli indicated that no patents that he has reviewed indicate that the drawings are to scale. Ken Smith pointed out that the current alleged grounds for rejecting many of Applicant's claims are based on ratios in patent drawings. Examiner Bastianelli stated that he does not find the claimed ratios to be patentable. Ken Smith asserted that *prima facie* obviousness has not been established and requested a new Office Action if the claims that recite ratios were being rejected on grounds other than the ratios allegedly illustrated in patent drawings as set forth in the Office Action. Examiner Bastianelli said he would talk with his supervisor and call Ken Smith back. Examiner Bastianelli called Ken Smith back and indicated that a new Office Action would not be provided.

### Amendments to the Specification

The Abstract and Summary have been amended by this response. There has been no objection in an Office Action that required these amendments.

Claim Status

By this response, claims 38, 63, 64, and 66 are amended, claim 55 is cancelled without prejudice or disclaimer, and new claims 67-78 are added. Claims 38-54, 56, and 58-78 are pending.

Claim Suggestions, 35 USC § 112 and Double Patenting

The Claim Suggestions, 35 USC § 112 and Double Patenting sections of the final Office Action were addressed in Applicant's response dated February 5, 2007.

Advisory Action

The Advisory Action states “[r]egarding MPEP 2125, this is for measuring distances in drawings not ratios which are relative to one another.” Advisory Action dated 2/22/2007. Applicant respectfully disagrees. In 2005, the Federal Circuit reaffirmed the well established rule stated in MPEP 2125 that it is inappropriate to rely upon patent drawings for disclosure of proportions of claim elements where there is no indication that the patent drawings are to scale. Nystrom v. Trex Co., 76 USPQ 2d 1481, 1491-1492 (Fed. Cir. 2005). The rejections of claims 41-46 all rely on the drawings of Tow for disclosure of the claimed proportions. The Advisory Action also states that “these ratios are another obvious feature to anyone skilled in the art.” Advisory Action dated 2/22/2007. Applicant respectfully points out that such a statement clearly does not establish *prima facie* obviousness of these claims. In order to establish *prima facie* obviousness the prior art references must teach or suggest all of the claim limitations. MPEP 2142. Applicant requests that the rejections of claims 41-46 be withdrawn.

The Advisory Action states that “Spock is live loaded from 46, 48 and 49 together with 42, 40 and 32.” Advisory Action dated 2/22/2007. Applicant respectfully points out that this statement is incorrect. The components 46, 48, 49, 42, 40 and 32 of Spock are all isolated from the sleeve 27 or packing by the cover 28 which is fixedly secured to the valve body 12 by bolts 30. Spock, Jr. et al., Figure 1 and col. 5, ll. 22-25. Components 42, 40 and 32 are sandwiched between component 44 and the cover 28 by components 46, 48, 49. Since the cover 28 is fixedly

secured to the valve body 12, no load applied by components 46, 48 and 49 is transferred to the sleeve 27 or packing. Claim 60 recites that the packing is live loaded. Claim 65 recites load members that apply a load to the packing over a range of temperatures while permitting the valve element to axially shift to compensate for temperature effects on the packing. Applicant requests that the rejections of claims 60 and 65 be withdrawn.

The Advisory Action States “[t]he valve cavity has a reduced diameter which inherently would prevent creeping.” Advisory Action dated 2/22/2007. Applicant respectfully points out that “[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). There is no indication that the configuration of the valving member 26 and the valve body 12 of Spock Jr. et al. would necessarily prevent creeping of the material of the sleeve 27 below the valving member 26. The bottom of the valving member 26 of Spock Jr. et al. is tapered away from the valve cavity, which makes creep more likely. See Spock Jr. et al., Figures 1 and 2. Claim 59 recites that the valve cavity comprises a reduced diameter bore that receives the lower trunnion and prevents packing material from creeping below said lower trunnion. Applicant requests that the rejection of claim 59 be withdrawn.

#### Claim Rejections - 35 USC § 102 and 103

The Office Action rejected claims 38-66 as being unpatentable over U.S. Patent No. 5,326,074 to Spock Jr. in view of U.S. Patent No. 5,730,420 to Tow. The Office Action rejected claims 38-60 and 62-66 as being unpatentable over Tow in view of U.S. Patent No. 3,214,135 to Hartmann. The Office Action rejected claims 64 and 65 as being anticipated by Hartmann.

Applicant respectfully submits that amended claim 38 is not obviousness in view of the Spock Jr. and Tow references, because amended claim 38 includes features that are not shown or suggested by the Spock Jr. or Tow references. For example, claim 38 recites a valve element with a cylindrical lower trunnion extending from a ball axially past a lower end of a single piece

packing. In the Spock Jr. valve, the areas of the plug valve element 26 that are above and below the passage 18 are not cylindrical and do not extend from a ball. In Tow, the lower trunnion of the valve element does not extend past the end of the packing.

Applicant stresses the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references. See *In re Lee*, 61 USPQ2d 1430, 1433-1434 (Fed. Cir. 2002). The Office Action asserts that the motivation to combine the Tow and Hartmann references is “in order to insure that the lower trunnion does not slip out of the packing” and that this is “strong motivation” Office Action dated 12/4/2006, p.6 and Advisory Action dated 2/22/2007. However, the Office Action has not relied upon any objective evidence to support this assertion and ignores the teaching in the Tow reference that molding the packing around the valve element tightly surrounds the valve element. Tow col. 2, ll. 34-43; col. 4, ll. 14-31. There is no indication in the Tow reference that the lower trunnion could possibly slip out of the tightly molded on packing. Clearly the motivation to combine the Tow and Hartmann references asserted in the Office Action is based on impermissible hindsight. Claim 38 is not obvious in view of the Tow and Hartmann references.

Claims 39, 40, 47-54, 55, 58, 61 and 62 depend from claim 38 and are allowable for at least the reasons claim 38 is allowable.

Claims 63 and 64 are independent claims that also recite that a lower trunnion extends axially past a lower end of the packing. Claims 63 and 64 are allowable for at least the reasons claim 38 is allowable.

Amended claim 66 is allowable over the applied references, because amended claim 66 includes features that are not shown or suggested by the applied references. For example, amended claim 66 recites a valve element that includes upper and lower cylindrical trunnions that extend from a ball and a stem having a smaller diameter than the upper cylindrical trunnion that extends from the upper cylindrical trunnion. Claim 66 also recites that the lower trunnion extends axially past a lower end of a packing. Amended claim 66 is in condition for allowance.

New claims 67-76 depend from claim 66 and are allowable for at least the reasons claim 66 is allowable.

New independent claim 78 is allowable for at least the reasons claim 66 is allowable.

The remainder of the claims are allowable for at least the reasons stated in the Advisory Action section above.

Should the Commissioner decide that any fee or fee deficiency is due, the Commissioner is hereby authorized to charge any and all such other fees incurred as a result of entering this amendment to deposit account number 03-0172, order number 22188/06985.

Respectfully submitted,



Date: March 29, 2007

Kenneth J. Smith, Reg. No. 45,115  
Customer No. 24024  
Telephone: 216-622-8674